



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,438	06/27/2005	Rudiger Fischer	CS8456/LeA 36,304	4454
34469	7590	08/03/2007		
BAYER CROPSCIENCE LP Patent Department 2 T.W. ALEXANDER DRIVE RESEARCH TRIANGLE PARK, NC 27709			EXAMINER RAO, DEEPAK R	
			ART UNIT 1624	PAPER NUMBER
			MAIL DATE 08/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/524,438	FISCHER ET AL.	
	Examiner	Art Unit	
	Deepak Rao	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 ~~8~~ are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 ~~8~~ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050211</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 11-21 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-15 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds of formula (I) wherein X, Y and Z represent independent substituents, does not reasonably provide enablement for compounds of formula (I) wherein X, Y and Z together represent a benzo grouping or represent alkylene or alkenylene group. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed. The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations.

The specification fails to enable the preparation of the entire scope of the claimed compounds. The process schemes in pages 4-6 of the specification, followed by the examples provide the essential starting materials to prepare the claimed compounds of formula (I). All the examples disclose compounds wherein X, Y and Z are selected from independent substituents, however, there is no disclosure of the sources of starting materials needed to prepare the compounds of formula (I) wherein X, Y and Z **together** represent a benzo grouping or represent alkylene or alkenylene. The specification provides processes of preparing the compounds wherein X, Y and Z are selected from independent substituents, however, does not provide any explanation or sources such that a person of ordinary skill could determine which groups are suitable to prepare compounds wherein X, Y and Z together represent a benzo grouping or alkylene or alkenylene. In view of the lack of direction provided in the specification regarding starting materials, the lack of working examples and the general unpredictability of chemical reactions, it would take an undue amount of experimentation for one skilled in the art to make the claimed compounds and therefore practice the invention. The starting material sources necessary to obtain the instant compounds must have been available as of the filing date in order to provide an enabling disclosure. See *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981); *Ex parte Moersch*, 104 USPQ 122 (POBA 1954). Applicants should show that the sources of these starting materials was common knowledge or readily available at the time of filing.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1624

Claims 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In the claims the definition of X, Y and Z is confusing. For example, in claim 11, it is recited that "X, Y, and Z independently of one another represent hydrogen, or C₁-C₄-alkoxycarbonyl;" and further, "**or** X, Y, and Z together represent a benzo alkyl having 1 to 4 carbon atoms, **and at least one of the radicals X, Y, or Z** represents a saturated or unsaturated monocyclic or bicyclic heterocyclyl grouping ...". In the above recitation, it is not understood if the condition that 'at least one of X, Y, or Z represents a heterocyclic group' is applicable only when X, Y, and Z together represent a group as defined in the claim or the claim always requires that 'at least one of X, Y, or Z represents a heterocyclic group'. As this condition is not indented separately and is stated in the same paragraph as the recitation of 'X, Y, and Z together', it causes confusion with respect to the claim recitation. Based on the specification and the examples, it appears that the invention compounds **require** that "at least one of X, Y, or Z represents a saturated or unsaturated heterocyclyl". Clarification and/or correction would obviate the rejection.
2. Regarding the claims, the phrase "if appropriate" (throughout the claims) renders the claim(s) indefinite because it is not clear whether or not the limitations following the phrase are present in the claimed invention. It raises a question, when 'not appropriate' what is intended in the claims.

Receipt is acknowledged of the Information Disclosure Statement filed on February 11, 2005 and a copy is enclosed herewith.

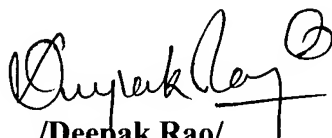
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


/Deepak Rao/
Primary Examiner
Art Unit 1624

August 1, 2007